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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,044	04/09/2007	Alfredo Larrea Napal	67341-2664PUS1; 02MRA0313	9498
26/096 7590 07/22/2008 CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009				
EXAMINER				
LUKS, JEREMY AUSTIN				
ART UNIT		PAPER NUMBER		
2837				
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07/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/576,044

Applicant(s)

LARREA NAPAL ET AL.

Examiner

JEREMY LUKS

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-893)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Stuart (6,430,921).

Stuart teaches an internal combustion engine exhaust component (Figure 2, #12) (see abstract) comprising: a shell (10) having an outer surface (clearly seen) and an inner surface (clearly seen) and defining a chamber (11), wherein the inner surface of the shell has a first part (22) susceptible to exhaust condensate contact and a second part (could be upper portion of muffler) not susceptible to the exhaust condensate contact, and a lining (19) applied over only the first part (22) of the inner surface of the shell (10) to protect the first part (22) from the exhaust condensate contact (Col. 4, Lines 19-35). Further, the claimed method steps are necessitated by the product structure, including: determining a part (could be #22) of the inner surface of the shell (10) which will be contacted by condensates when in operation (Col. 4, Lines 19-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 3, 6, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart (6,430,921).

Regarding Claims 2, 3, 8, 9 and 11, Stuart is relied upon for the reasons and disclosures set forth above. Stuart further teaches an internal combustion engine exhaust component (Figure 2, #12) (see abstract) comprising: a shell (10) having an outer surface (clearly seen) and an inner surface (clearly seen) and defining a chamber (11), and a lining (19) applied over a portion of the inner surface of the shell (10), wherein the coverage area depends on the design of the exhaust component (10) (Col. 4, Lines 19-35); wherein the shell (10) has a shell thickness and the lining (19) has a lining thickness (24), and wherein it is important to minimize the thickness of the liner (19) in order to maximize the exhaust component (12) flow (Col. 4, Line 44 – Col. 5, Line 3).

Stuart fails to explicitly teach wherein the lining covers approximately one-third to one-half of a surface area of the inner surface of the shell, and wherein the shell thickness is thicker than the lining thickness.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide wherein the lining covers approximately one-third to one-

half of a surface area of the inner surface of the shell, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working range involves only routine skill in the art. In re Aller, 105 USPQ 233. It would have been an obvious design choice to provide wherein the shell thickness is thicker than the lining thickness, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Further, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the Art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Further, the claimed method steps are necessitated by the product structure.

Regarding Claim 6, Stuart inherently teaches the steps of providing a substantially flat sheet of material (shell 10 will be flat prior to forming), applying the lining (19) to the substantially flat sheet of material and then forming the substantially flat sheet of material into a shape of the shell (10), as it is well known in the art to construct a muffler body by forming a shell from a sheet material.

3. Claims 4, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart (6,430,921) in view of Cullen (4,947,957). Stuart is relied upon for the reasons and disclosures set forth above. Stuart further teaches a lining (19) applied over a portion of the inner surface of the shell (10). Stuart fails to teach wherein the lining is applied to the shell by spot welding.

Cullen teaches applying a lining (Figure 4, #10) to a surface (14) within an exhaust component by spot welding (39) (Col. 3, Lines 3-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Stuart, with the apparatus of Cullen to provide a well known, stable method of attaching components within an exhaust structure. *KSR International Co. v. Teleflex Inc.*, 82 USPQ 2d 1385 (2007). Further (with respect to claims 4 and 10), the method of forming a device is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given little patentable weight.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent arts of record relating to internal combustion engine exhaust components and a method of making an internal combustion engine exhaust component are disclosed in the PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Luks whose telephone number is (571) 272-2707. The examiner can normally be reached on Monday-Thursday 8:30-6:00, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Benson can be reached on (571) 272-2227. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2837

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy Luks/
Patent Examiner
Art Unit 2837
Class 181

/Edgardo San Martin/
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